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Herman Rodriguez

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EXAMINER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* HERMAN RODRIGUEZ, NEWTON  
9 JAMES SMITH, JR., and CLIFFORD JAY SPINAC  
10

11  
12 Appeal 2009-000170  
13 Application 09/704,569  
14 Technology Center 3600  
15

16  
17 Decided:<sup>1</sup> June 11, 2009  
18  
19

20 Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R.  
21 MOHANTY, *Administrative Patent Judges*.

22  
23 FETTING, *Administrative Patent Judge*.  
24

25  
26 DECISION ON APPEAL

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<sup>1</sup> The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Herman Rodriguez, Newton James Smith, Jr., and Clifford Jay Spinac (Appellants) seek review under 35 U.S.C. § 134 of a non-final rejection of claims 1, 3-10, 14, 15, 18, 20-23, 25, 27, 28, 30-33, 35, and 37-41, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

We AFFIRM-IN-PART.

The Appellants invented a way for a travel agent to maintain a travel profile so users could perform actions that a user wishes to execute while the user is away from the office. These actions can be bundled into a travel package that is transmitted to the user in response to the user making travel arrangements. The travel agent can be an automated agent, such as an on-line travel agent, or a traditional brick-and-mortar travel agent that is used by the traveler. The travel agent processes the user's travel request and reads the user's profile for actions that the user would like to take while he is away. Once the actions are combined into a travel package, they are transmitted for processing. (Specification 5:2-14).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A method of handling travel arrangements, said method comprising:  
[1] scheduling the travel arrangements using a computer system;  
[2] recording the scheduled travel arrangements on a nonvolatile storage device connected to the computer system;  
and

[3] sending one or more automated requests corresponding to the travel arrangements

[3a] from the computer system to one or more service agents,

[3b] wherein the automated requests are based on a traveler's user profile, and

[3c] wherein at least one of the service agents are selected from the group consisting of

a delivery service agent,

a telephone system,

an electronic calendar system, and

a medical information system.

This appeal arises from the Examiner's Non-Final Rejection, mailed December 4, 2006. The Appellants filed an Appeal Brief in support of the appeal on April 16, 2007. An Examiner's Answer to the Appeal Brief was mailed on August 2, 2007. A Reply Brief was filed on September 19, 2007.

#### PRIOR ART

The Examiner relies upon the following prior art:

Berman	US 5,995,939	Nov. 30, 1999
Levine	US 6,076,121	Jun. 13, 2000
Gershman	US 6,401,085 B1	Jun. 4, 2002
Chong	US 2002/0111845 A1	Aug. 15, 2002
Felger	US 6,553,108 B1	Apr. 22, 2003

#### REJECTIONS

Claims 1, 3, 18, 20, 28, and 30 stand rejected under 35 U.S.C. § 102(e) as anticipated by Chong.

Claims 25, 35, and 41 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Chong and Gershman.

Claims 4-10, 21-23, and 31-33 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Chong and Levine.

Claims 14, 15, 27, and 37 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Chong and Berman.

Claims 38-40 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Chong and Felger.

## ISSUES

The issue of whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1, 3, 18, 20, 28, and 30 under 35 U.S.C. § 102(e) as anticipated by Chong hinges primarily on whether Chong describes sending automated requests corresponding to travel arrangements to a service agent based on a user profile wherein at least one of the service agents are selected from the group consisting of a delivery service agent, a telephone system, an electronic calendar system, and a medical information system.

The issue of whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 25, 35, and 41 under 35 U.S.C. § 103(a) as unpatentable over Chong and Gershman hinges primarily on whether it was predictable to send Chong's automated travel request to Gershman's calendaring system.

The issue of whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 4-10, 21-23, and 31-33 under 35 U.S.C. § 103(a) as unpatentable over Chong and Levine hinges primarily on whether it was predictable to send Chong's automated travel request for services provided in relation to Levine's postal services.

The issue of whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 14, 15, 27, and 37 under 35 U.S.C. § 103(a) as unpatentable over Chong and Berman hinges primarily on whether it was predictable to send Chong's automated travel request to sources of medical information as in Berman.

The issue of whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 38-40 under 35 U.S.C. § 103(a) as unpatentable over Chong and Felger hinges primarily on whether it was predictable to send Chong's automated travel request to fund an electronic wallet as in Felger.

## FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

*Chong*

01. Chong is directed to a way for a meeting planner to enter sensitive data in the planning of an event using facilities and resources accessed through the public Internet, and yet have control of the sensitive data to secure it from access by unauthorized persons while being able to incorporate the sensitive data with sophisticated meeting facilitation functions that are accessible online to participants of the event (Chong ¶ 0011).

02. Possible users for the Chong's Secure PC meeting planner node include travel planning consultants, travel agencies, and incentive company planners (Chong ¶ 0026).

03. The planning for group events typically starts with the selection of the event dates and the destination location of the meeting group. The meeting location may be selected based upon geographic proximity to the company or the targeted attendees, travel cost data, company preferences for a particular destination, hotel, or physical host site, etc. The CMP assembles the detailed meeting planning data at the Secure PC node facilitated by access to company personnel records, historical meeting planning records, etc. The meeting planning data can include very personal or sensitive employee data, such as names, home telephone numbers, home addresses, email addresses, expense account information, intranet passwords, personal preferences, credit card numbers for non-company expenditures, medical information, required medications, physical restrictions, etc. It can also include company proprietary information, such as planned conference proceedings, and meeting costing and budget analyses (Chong ¶ 0027).

04. Chong loads data of a tentative meeting plan including the event location, physical host site, preferred airline carriers, and preferred hotels (Chong ¶ 0031).

05. Chong generates detailed service requests for any vendor based on entered data and tracks the status of service requests (Chong 6:Table 1, Items 4.A and B).

*Gershman*

06. Gershman is directed to a portable portal into the Internet. Its wireless device transmits a query to a service routine which then

1 queries the Web to find price, shipping, and availability.  
2 information from various Web suppliers (Gershman 3:18-23).

3 07. Gershman describes BackgroundFinder (BF) as an agent  
4 responsible for preparing an individual for an upcoming meeting  
5 by helping him/her retrieve relevant information about the  
6 meeting from various sources. BF receives input text in character  
7 form indicative of the target meeting. The input text is generated  
8 by a calendar program that includes the time of the meeting. As  
9 the time of the meeting approaches, the calendar program is  
10 queried to obtain the text of the target event and the agent parses  
11 the input meeting text to extract its various components such as  
12 title, body, participants, location, and time. Then, the system  
13 queries the web for relevant information concerning the topic.  
14 The system updates the calendaring system and eventually the  
15 user with the best information it can gather to prepare the user for  
16 the target meeting (Gershman 10:58-11:15).

17 *Levine*

18 08. Levine is directed to network for transporting an item between  
19 points within the network (Levine 8:30-32).

20 *Berman*

21 09. Berman is directed to automated service request and fulfillment  
22 systems, particularly systems in which requests are made and  
23 fulfilled over a computer network (Berman 1:10-14).

24 *Fleger*

25 10. Felger is directed to payment authorization and billing  
26 arrangement for products, services, and value-added



1 telecommunication services purchased over a computer network  
2 (Felger 1:46-50).

3 11. Felger describes the use of electronic wallets for payment  
4 (Felger 13:64-66).

5 *Facts Related To The Level Of Skill In The Art*

6 12. Neither the Examiner nor the Appellants has addressed the level  
7 of ordinary skill in the pertinent arts of systems analysis and  
8 programming, automated messaging systems, travel services,  
9 personal services, and data communications. We will therefore  
10 consider the cited prior art as representative of the level of  
11 ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350,  
12 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the  
13 level of skill in the art does not give rise to reversible error ‘where  
14 the prior art itself reflects an appropriate level and a need for  
15 testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v.*  
16 *Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

17 *Facts Related To Secondary Considerations*

18 13. There is no evidence on record of secondary considerations of  
19 non-obviousness for our consideration.  
20

21 PRINCIPLES OF LAW

22 *Anticipation*

23 "A claim is anticipated only if each and every element as set forth in  
24 the claim is found, either expressly or inherently described, in a single prior  
25 art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d  
26 628, 631 (Fed. Cir. 1987). "When a claim covers several structures or

1 compositions, either generically or as alternatives, the claim is deemed  
2 anticipated if any of the structures or compositions within the scope of the  
3 claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed.  
4 Cir. 2001). "The identical invention must be shown in as complete detail as  
5 is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d  
6 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by  
7 the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology  
8 is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

9 *Obviousness*

10 A claimed invention is unpatentable if the differences between it and  
11 the prior art are "such that the subject matter as a whole would have been  
12 obvious at the time the invention was made to a person having ordinary skill  
13 in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l Co. v. Teleflex Inc.*, 550  
14 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

15 In *Graham*, the Court held that the obviousness analysis is bottomed  
16 on several basic factual inquiries: "[ (1) ] the scope and content of the prior art  
17 are to be determined; [ (2) ] differences between the prior art and the claims at  
18 issue are to be ascertained; and [ (3) ] the level of ordinary skill in the  
19 pertinent art resolved." 383 U.S. at 17. *See also KSR*, 550 U.S. at 406.

20 "The combination of familiar elements according to known methods is likely  
21 to be obvious when it does no more than yield predictable results." *Id.* at  
22 416.

23  
24 ANALYSIS

25 *Claims 1, 3, 18, 20, 28, and 30 rejected under 35 U.S.C. § 102(e) as*  
26 *anticipated by Chong.*

1           Claims 1, 18, and 28 are the only independent claims in the  
2 application. The Appellants argue these claims 1, 3, 18, 20, 28, and 30 as a  
3 group. Accordingly, we select claim 1 as representative of the group.  
4 37 C.F.R. § 41.37(c)(1)(vii) (2008).

5           The Appellants contend that Chong does not describe limitation [3] of  
6 sending automated requests corresponding to travel arrangements to a  
7 service agent based on a user profile wherein at least one of the service  
8 agents are selected from the group consisting of a delivery service agent, a  
9 telephone system, an electronic calendar system, and a medical information  
10 system (Br. 8:First full ¶) and, in particular, that Chong does not describe its  
11 service requests as corresponding to any travel arrangements (Br. 9:Second  
12 full ¶).

13           The Examiner replied that Chong described sending such service  
14 requests at paragraph 0027 and Table 1 (Answer 16-17). We agree with the  
15 Examiner. Chong generates detailed service requests for any vendor based  
16 on entered data and tracks the status of service requests (FF 05). Since this  
17 is done by Chong's system, such sending is automatic. The Appellants  
18 contend that Chong does not describe which types of requests these pertain  
19 to (Br. 8:Bottom ¶).

20           We find the scope of these service requests is implied by Chong's  
21 description that such requests are for any vendor based on entered data; thus  
22 such requests are for any vendors providing services. Chong states that  
23 possible users include travel agencies (FF 02). Chong describes selecting a  
24 meeting location based upon geographic proximity and travel cost data (FF  
25 03) and loads data including the preferred airline carriers and preferred  
26 hotels (FF 04). Thus, such airlines and hotels are among the vendors

1 Chong's system uses for the meetings based on travel cost data. Airlines are  
2 known to be delivery service agents. Finally, Chong describes using a user  
3 profile in the form of personnel records (FF 03).

4 Thus, we find that Chong describes sending automated requests  
5 corresponding to travel arrangements to a service agent based on a user  
6 profile wherein at least one of the service agents are selected from the group  
7 consisting of a delivery service agent, a telephone system, an electronic  
8 calendar system, and a medical information system. We accordingly find  
9 the Appellants' arguments unpersuasive.

10  
11 *Claims 25, 35, and 41 rejected under 35 U.S.C. § 103(a) as unpatentable*  
12 *over Chong and Gershman.*

13 Claim 25 requires receiving the automated request at, and updating, an  
14 electronic calendar with the information. The Appellants contend Gershman  
15 does not describe receiving the automated requests from the independent  
16 claims at a calendaring system (Br. 10). We agree with the Appellants.

17 The Examiner responds that Gershman describes updating a  
18 calendaring system and then invokes *KSR* to find that such updating is no  
19 more than combining Gershman's calendar updating with Chong's system  
20 (Answer 18). The Examiner overlooks the fact that the independent claims  
21 require that the received automated requests are those sent from the claimed  
22 travel automation tool, a tool unrelated to the calendaring system.

23 Gershman's calendar update comes from the results of a query generated by  
24 the calendar program itself, not from requests for travel separate from the  
25 calendar program (FF 07). While we agree with the Examiner that under

1 *KSR*, an explicit description of motivation is not required to be found in the  
2 references themselves, *KSR* does require an explicit rationale in the record.

3 Often, it will be necessary for a court to look to interrelated  
4 teachings of multiple patents; the effects of demands known to  
5 the design community or present in the marketplace; and the  
6 background knowledge possessed by a person having ordinary  
7 skill in the art, all in order to determine whether there was an  
8 apparent reason to combine the known elements in the fashion  
9 claimed by the patent at issue. To facilitate review, this  
10 analysis should be made explicit.

11 *KSR*, 550 U.S. at 417-18. The Examiner provides no rationale why one of  
12 ordinary skill would have found it predictable to provide such automated  
13 requests to Gershman's calendaring system, and therefore has failed to put  
14 forward a prima facie case. The remaining claims contain a similar  
15 limitation.

16  
17 *Claims 4-10, 21-23, and 31-33 rejected under 35 U.S.C. § 103(a) as*  
18 *unpatentable over Chong and Levine.*

19 Claim 4 adds the elements of "wherein the delivery service agents  
20 include one or more parcel services, and wherein the automated requests  
21 include one of holding packages for customer pickup, delivering packages  
22 on a future date, and leaving packages with a neighbor."

23 Claim 5 adds the elements of "wherein the delivery service agent  
24 includes a post office, and wherein the automated requests include at least  
25 one of holding mail for customer pickup, delivering mail on a future date,  
26 and forwarding mail to another address."

27 Claim 6 adds the elements of "wherein the delivery service agent  
28 includes a company mailroom, and wherein the automated requests include

1 at least one of holding mail for future pickup, delivering mail on a future  
2 date, and forwarding mail to another address."

3 Claims 21 and 31 add the elements of "wherein the automated  
4 requests include at least one of holding packages for future pickup,  
5 delivering packages on a future date, and leaving packages at an alternate  
6 location."

7 Claims 7, 22, and 32 include the additional limitation of "wherein the  
8 sending automated requests include configuring instructions corresponding  
9 to a telephone."

10 The remaining claims depend from these claims.

11 The Appellants contend Levine does not describe these (Br. 15-16).  
12 We agree with the Appellants. The Examiner responds that these added  
13 limitations are obvious over Levine because Levine is directed to postal  
14 operations and these limitations are well known postal related operations  
15 (Answer 19). The Examiner overlooks the fact that these limitations are for  
16 requests that are automatically sent from the claimed travel automation tool,  
17 a tool unrelated to the postal operations. The Examiner cites no portion of  
18 Levine describing such automated requests and we are unable to find any  
19 such description within Levine. The Examiner provides no rationale why  
20 one of ordinary skill would have found it predictable to provide such  
21 automated requests for postal services.

22  
23 *Claims 14, 15, 27, and 37 rejected under 35 U.S.C. § 103(a) as unpatentable*  
24 *over Chong and Berman.*

1 All of these claims require that the automated request be related to  
2 medical information or retrieve medical information. The Appellants argue  
3 Berman does not describe these (Br. 18-19). We agree with the Appellants.

4 The Examiner responds that these added limitations are obvious over  
5 Berman because they merely unite old elements with no change in function.  
6 (Answer 21). The Examiner overlooks the fact that these limitations are for  
7 requests that are automatically sent from the claimed travel automation tool,  
8 a tool unrelated to the medical information. Thus, the claims are directed to  
9 more than the mere combination of automated requests to vendors and  
10 automated requests for medical information. They are directed to obtaining  
11 such medical information requests from requests for travel. The Examiner  
12 cites no portion of Berman describing such automated requests and we are  
13 unable to find any such description within Berman. The Examiner provides  
14 no rationale why one of ordinary skill would have found it predictable to  
15 provide such automated requests for medical information.

16  
17 *Claims 38-40 rejected under 35 U.S.C. § 103(a) as unpatentable over Chong*  
18 *and Felger.*

19 Claim 38 requires increasing a user's electronic wallet balance and  
20 decreasing a user's bank account balance. The Appellants argue that neither  
21 reference describes the wallet change resulting from a travel related request  
22 (Br. 19-20).

23 We agree with the Appellants. The Examiner refers to Felger's  
24 description of paying a fee which would decrease the bank account. The  
25 Examiner argues that since the fee is associated with the wallet, funds were  
26 transferred into the wallet (Answer 21-22). The Examiner overlooks the fact

1 that these transactions must result from requests that are automatically sent  
2 from the claimed travel automation tool, a tool unrelated to the electronic  
3 wallet. Thus, the claims are directed to more than the mere combination of  
4 automated requests to vendors and automated requests for updating a wallet.  
5 They are directed to obtaining such wallet funding from requests for travel.  
6 The Examiner cites no portion of Felger describing such automated requests  
7 and we are unable to find any such description within Felger. The Examiner  
8 provides no rationale why one of ordinary skill would have found it  
9 predictable to provide such automated requests for wallet funding.

10  
11 **CONCLUSIONS OF LAW**

12 The Appellants have not sustained their burden of showing that the  
13 Examiner erred in rejecting claims 1, 3, 18, 20, 28, and 30 under 35 U.S.C. §  
14 102(e) as anticipated by Chong.

15 The Appellants have sustained their burden of showing that the  
16 Examiner erred in rejecting claims 25, 35, and 41 under 35 U.S.C. § 103(a)  
17 as unpatentable over Chong and Gershman.

18 The Appellants have sustained their burden of showing that the  
19 Examiner erred in rejecting claims 4-10, 21-23, and 31-33 under 35 U.S.C. §  
20 103(a) as unpatentable over Chong and Levine.

21 The Appellants have sustained their burden of showing that the  
22 Examiner erred in rejecting claims 14, 15, 27, and 37 under 35 U.S.C. §  
23 103(a) as unpatentable over Chong and Berman.

24 The Appellants have sustained their burden of showing that the  
25 Examiner erred in rejecting claims 38-40 under 35 U.S.C. § 103(a) as  
26 unpatentable over Chong and Felger.



DECISION

To summarize, our decision is as follows:

- The rejection of claims 1, 3, 18, 20, 28, and 30 under 35 U.S.C. § 102(e) as anticipated by Chong is sustained.
- The rejection of claims 25, 35, and 41 under 35 U.S.C. § 103(a) as unpatentable over Chong and Gershman is not sustained.
- The rejection of claims 4-10, 21-23, and 31-33 under 35 U.S.C. § 103(a) as unpatentable over Chong and Levine is not sustained.
- The rejection of claims 14, 15, 27, and 37 under 35 U.S.C. § 103(a) as unpatentable over Chong and Berman is not sustained.
- The rejection of claims 38-40 under 35 U.S.C. § 103(a) as unpatentable over Chong and Felger is not sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

hh

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